

### **REMARKS**

Claims 1-6 and 21-49 are presently pending in this application. Claims 35 and 46 have been amended, but no new matter has been added. Claims 1, 26, 35, and 46 are independent. Applicant respectfully traverses the Rejections/Objections, which are discussed below.

#### ***Claim Rejection under 35 U.S.C. § 112***

Claim 46 was rejected under 35 U.S.C. § 112 as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, the Office indicated that there is insufficient antecedent basis for the limitation “the proximal” in line 10 of the claim. Applicant has amended this claim to change “the proximal” to “the proximal end,” which Applicant believes obviates the Office’s rejection. Accordingly, Applicant requests withdrawal of the rejections of claim 46 and 47-49, which depend from claim 46.

#### ***Claim Rejections under 35 U.S.C. § 102***

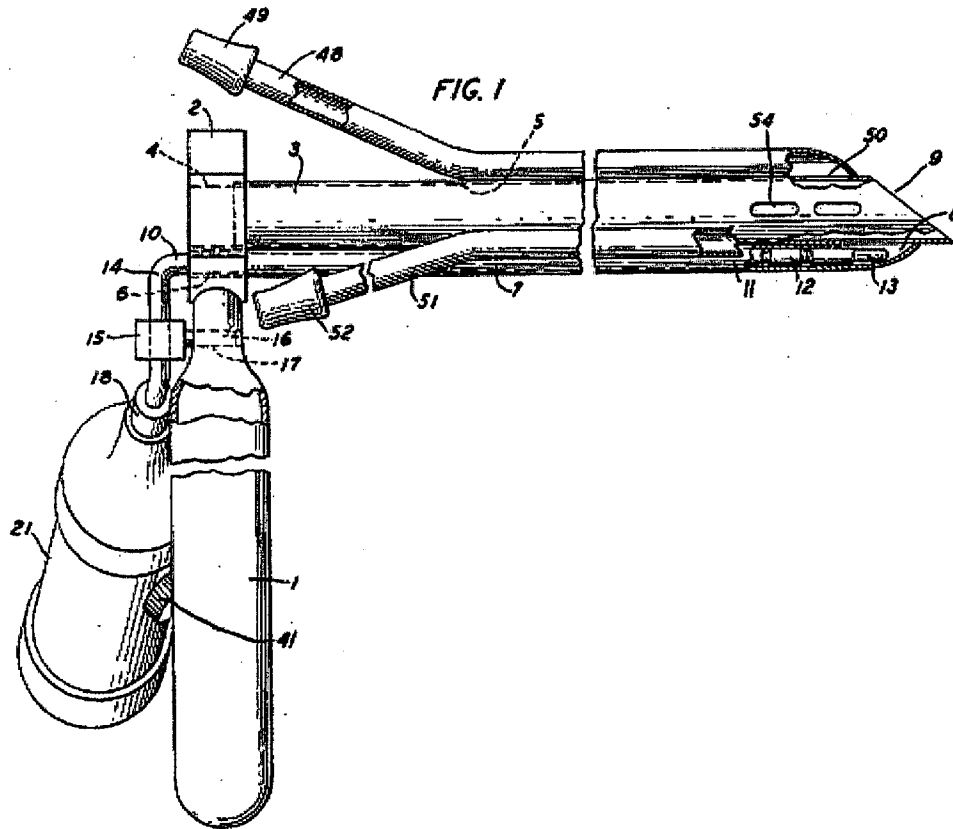
Claims 1-2, 4, 6, 21-28, and 30-34 were rejected under 35 U.S.C. § 102(b) as anticipated by U.S. Patent No. 2,911,968 to Schueler et al. (“Schueler”). Applicant respectfully traverses and submits that claims 1-2, 4, 6, 21-28, and 30-34 recite subject matter not disclosed by Schueler.

Regarding claim 1, Schueler fails to anticipate claim 1 because Schueler fails to disclose each and every element of claim 1. For instance, the disclosure of Schueler lacks a “base for coupling to the handle,” as claim 1 requires.

The office contends that Schueler discloses a base, but the Office does not cite to any specific portion of Schueler to support its contention. For this reason alone, the rejection of claim 1 is improper.

Additionally, the disclosure of Schueler lacks “an elongated blade secured to the base, said elongated blade having a proximal end, a distal end, an upper surface, and a lower surface, said lower surface of said elongated blade being secured to said base at

said proximal end,” as claim 1 requires. The Office contends that element 3 from Schueler’s Figure 1 (reproduced below for convenience) is an elongated blade. It is not.



Schueler’s Figure 1

Instead, element 3 is a hollow tube. *See* Schueler at col. 2, lines 16-39. The “hollow tube 3 extends substantially at a right angles” to the handle 1 and can be of “any required or convenient length.” *Id.* The tube 3 has a “longitudinal bore 5 of an appropriate diameter... for the insertion there through of an appropriate instrument such as a biopsic forceps or a telescope.” *Id.* In sum, Schueler discloses a hollow tube into which instruments can be inserted.

The present application, however, requires an elongated blade. A blade is “a flat thin part or section, especially one that makes contact to perform a desired action: the blade of an oar; the blade of a hockey stick.” *See, e.g.* “blade” Dictionary.com. The American Heritage® Dictionary of the English Language, Fourth Edition. Houghton Mifflin Company, 2004, *available at* <http://dictionary.reference.com/browse/blade> (last

accessed: December 17, 2007). Consistent with this definition, the present application describes a blade in detail as comprising “a proximal end 32, a distal end 28, an upper surface 24, and a lower surface 26.” *See* Present Application at [0032]; *see also* Applicant’s Figure 1 (reproduced below). A hollow tube is not a blade. Thus, Schueler fails to disclose an elongated blade. For this additional reason, the rejection of claim 1 is should be withdrawn.

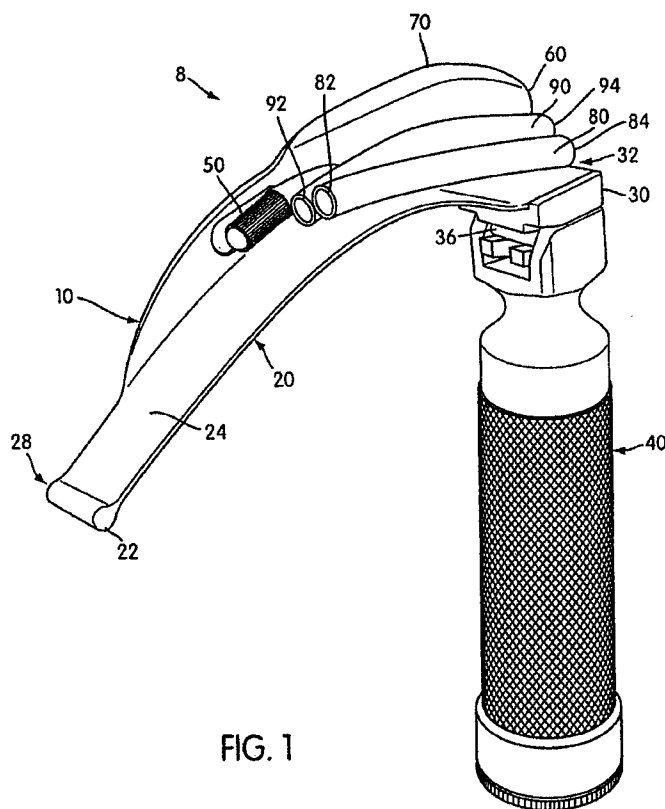


FIG. 1

Applicant’s Figure 1

Applicant, therefore, respectfully requests withdrawal of the rejections of claim 1 and of claims 2, 4, 6, and 21-25, which depend from claim 1.

Regarding claim 26, Schueler fails to anticipate claim 26 because Schueler fails to disclose each and every element of claim 26. For instance, as stated above with reference to claim 1, Schueler fails to disclose “an elongated blade secured to the base, said elongated blade having a proximal end, a distal end, an upper surface, and a lower surface, said lower surface of said elongated blade being secured to said base at said proximal end,” as claim 26 requires. Applicant, therefore, respectfully requests that the

rejections of claim 26 and claims 27-28, and 30-34, which depend from claim 26, be withdrawn.

***Claim Rejections under 35 U.S.C. § 103***

Claims 3, 5, and 29 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Schueler in view of U.S. Patent No. 6,248,061 to Cook, Jr. (“Cook”). Applicant respectfully traverses and submits claims 3, 5, and 29 recite subject matter not disclosed or suggested by the combination of Schueler and Cook.

Claim 3, which depends from claim 1, is patentable for at least the same reasons stated above regarding claim 1 and the rejection of claim 3 should be withdrawn on this basis alone. Claim 3, however, is also patentable because neither Schueler nor Cook, alone or in combination, teach or suggest all of the elements of claim 3. For instance, neither reference teaches a blade assembly wherein “the curved portion of the second guide tube is curved in conformity to the curvature of the elongated blade and the first guide tube is not curved in general conformity to the curvature of the blade because said first guide tube is substantially straight along its entire length,” as claim 3 requires.

The Office has alleged that it would be obvious to combine the teachings of Schueler with the curved blade of Cook. *See* Office Action at 5. However, the Office has failed to allege that either reference discloses “a second guide tube curved in conformity to the curvature of the elongated blade” and “a first guide tube that is substantially straight along its entire length.” Because the office does not even contend that either references discloses a second guide tube curved in conformity to the curvature of the elongated blade and a first guide tube that is substantially straight along its entire length, the Office has not established a *prima facie* case of obviousness.

The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. *See* MPEP § 2142. To support an obviousness rejection the examiner must clearly articulation the reasons why the claimed invention would have been obvious. *See* MPEP § 2143. In so doing, “[a]ll words in a claim must be considered.” MPEP § 2143.03. In this case, the Office has not met its burden because it has failed to contend that – yet alone clearly articulate the reasons why – each and every element of claim 3 is present in the prior art.

Accordingly, the rejection of claim 3 as unpatentable over Schueler in view of Cook is improper because the combination fails to teach or suggest all the elements of claim 3. Applicant, therefore, respectfully requests that the rejection of claim 3 be withdrawn for this additional reason.

Claim 5, which depends from claim 1, is patentable for at least the same reasons stated above regarding claim 1 and the rejection of claim 5 should be withdrawn on this basis alone. Claim 5, however, is also patentable because neither Schueler nor Cook, alone or in combination, teach or suggest a blade assembly comprising “a tongue deflector having a portion extending in a direction transverse to the upper surface of the elongated blade along a marginal edge segment of said elongated blade” as claim 5 requires. The Office has pointed to no portion of any reference that teaches this feature and Applicant can find no mention of such a feature in any reference. Accordingly, rejection of claim 5 as unpatentable over Schueler in view of Cook is improper because the combination fails to teach or suggest all the elements of claim 5. Applicant, therefore, respectfully requests the withdrawal of the rejection of claim 5 for this additional reason.

Claim 29, which depends from claim 26, is patentable for at least the same reasons stated above regarding claim 26 and the rejection of claim 29 should be withdrawn on this basis alone. Claim 29, however, is also patentable because neither Schueler nor Cook, alone or in combination, teach or suggest an assembly “wherein said elongated blade is curved and said curved portion of the second guide tube follows the curve of the elongated blade,” as claim 29 requires. Such a feature is not present in the combination of Schueler and Cook and the Office has not alleged that it is. Accordingly, rejection of claim 29 as unpatentable over Schueler in view of Cook is improper because the combination fails to teach or suggest all the elements of claim 29. Applicant, therefore, respectfully requests the withdrawal of the rejection of claim 29 for this additional reason.

Claims 35-45 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Cook in view of Schueler. Applicant respectfully traverses and submits that claims 35-45 recite subject matter not disclosed or suggested by the combination of Cook and Schueler.

Claim 35, as amended, is patentable over Cook in view of Schueler because neither Cook nor Schueler, alone or in combination, teach or suggest all of the elements of claim 35. For instance, neither reference discloses a blade assembly comprising first and second tubes extended through the first and second guide tubes as claim 35 requires.

The Office makes much of the fact that Cook discloses a “suction tube,” however a suction tube is not tube extended through a guide tube. Instead,

a suction tube 81 generally includes a suction end 82 and an adaption end 84. The adapter 86 is to provide connection of the suction tube 81 to a suction source 92.... Preferably, adapter 86 is positioned in adaption end 84 and connects to a suction catheter 90, which connects to a suction/vacuum source 92

Cook at Col. 5, lines 49-56. Nowhere does Cook disclose first and second tubes extended through first and second guide tubes. Accordingly Cook fails to disclose each and every element of claim 35.

Schueler fails to make up for the deficient teachings of Cook because Schueler also fails to disclose first and second tubes extended through first and second guide tubes, respectively. Schueler does teach upper aspirator tube 48 and lateral aspirator tube 51, but these aspirator tubes are not first and second tubes extended through first and second guide tubes as claim 35 requires. Accordingly, Schueler does not make up for Cook’s deficiencies.


Thus, Cook, Schueler, and the combination of the two fail to teach or suggest all of the elements of claim 35. Applicant, therefore, respectfully requests withdrawal of the rejections of claims 35 and 36-45, which depend from claim 35.

### CONCLUSION

All of the stated grounds of objection and rejection have been properly traversed, accommodated, or rendered moot. Applicant therefore respectfully requests that the Examiner reconsider all presently outstanding objections and rejections, and that they be withdrawn. Applicant believes that a full and complete reply has been made to the

outstanding Office Action and, as such, the present application is in condition for allowance.

If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

RESPECTFULLY SUBMITTED,					
NAME AND REG. NUMBER	Brian Rosenbloom, Registration No.: 41,276				
SIGNATURE				DATE	1/15/08
Address	Rothwell, Figg, Ernst & Manbeck Suite 800, 1425 K Street, N.W.				
City	Washington	State	D.C.	Zip Code	20005
Country	U.S.A.	Telephone	202-783-6040	Fax	202-783-6031

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